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10/504,817

03/01/2005

Nobuyuki Takakuwa

8048-1054

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EXAMINER

HASAN, SYED Y

ART UNIT

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2621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/504,817 | Applicant(s) TAKAKUWA ET AL. | |
| | Examiner SYED Y. HASAN | Art Unit 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/17/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25 - 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25 - 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/17/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Amendment Acknowledgement

1. Receipt is acknowledged of preliminary amendment filed 8/17/2004.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility " (Official Gazette notice of 22 November 2005), Annex IV reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claims 25 - 33 and 45 – 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claims 25 - 33 define “recording medium” with descriptive material. While “functional descriptive material” may be claimed as a statutory product (i.e., a “manufacture”) while embodied on a tangible computer readable medium, recording medium embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible “thing”) and therefore does not fall within one of the four statutory class of §101. Rather, “medium” is a form of energy, in the absence of any physical structure or tangible material.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer- readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory.

Examiner recommends changing “A storage medium including a computer program stored therein” to “A computer readable recording medium on which a program is recorded”.

Claims 45 - 47 define a “computer program” with descriptive material.

A “program” embodying functional descriptive material is neither a process nor a product (i. e. a tangible “thing”) and therefore does not fall into one of the four statutory class of 101. Rather a “program” is a form of energy, in the absence of any physical structure or a tangible material.

Because the full scope of the claim as properly read in light of the disclosure

encompasses non- statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible readable computer readable media, while at the same time excluding the intangible media such as software, signals, carrier waves, etc. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 25, 34, 35, 45 and 48 recite the limitation "wherein discontinuity information". There is insufficient antecedent basis for this limitation in the claim. The phrase "discontinuity information" is not introduced before any of these independent claims.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11F.3d 1046, 29 USPQ 2d 2010 (Fed. Cir. 1993); *In re Long*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 25 - 48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22 - 42 of copending Application No. 10/504,817. Although some of the conflicting claims are not identical, they are not patentably distinct from each other.

7. Claims 25, 34, 35, 45 and 48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 22, 28, 29, 39 and 42 of copending Application No. 10/504,475 in view of Kusaka et al (US 7231134)

Regarding **claims 25, 34, 35, 45 and 48** of this application, claims 22, 28, 29, 39 and 42 respectively of copending Application No. 10/504,475 as discussed above, recite all the claimed limitations except for related group definition information for defining as a related group a set having a specific relation out of a plurality of content information constructing the plurality of portion streams and given to said related group definition information commonly with respect to a plurality of related groups

On the other hand Kusaka et al teaches related group definition information for defining as a related group a set having a specific relation out of a plurality of content information constructing the plurality of portion streams and given to said related group definition information commonly with respect to a plurality of related groups (col 30,

lines 2 - 26).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate related group definition information for defining as a related group a set having a specific relation out of a plurality of content information constructing the plurality of portion streams and given to said related group definition information commonly with respect to a plurality of related groups as taught by Kusaka et al in claims 25, 34, 35, 45 and 48 of copending Application No. 10/504,475 in order to freely and easily combine files and reproduce them effectively by the user.

8. Claim 26 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 22 of copending Application No. 10/504,475 in view of Kato et al (US 6950604)

Regarding **claim 26** of this application, claim 22 of copending Application No. 10/504,475 as discussed above, recite all the claimed limitations except for wherein the discontinuity information is unified and written with respect to the plurality of related groups

On the other hand Kato et al teaches wherein the discontinuity information is unified and written with respect to the plurality of related groups(col 5, lines 51 – 58, here Discontinuity Information Table illustrates that the discontinuity is unified and has a plurality of related groups).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate wherein the discontinuity information is unified and written with respect to the plurality of related groups as taught by Kato et al in claim 22 of copending

Application No. 10/504,475 in order for the users to repeatedly view programs without degradation in picture and sound qualities.

9. Claim 32 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 22 of copending Application No. 10/504,475

Regarding **claim 32** of this application, claim 22 of copending Application No. 10/504,475 as discussed above, recite all the claimed limitations including wherein said object information file further stores, as the reproduction control information, but does not disclose sub group definition information for defining as a sub group a set of a plurality of portion streams which are mutually changeable upon reproducing in the related group.

This limitation is well known in the art. Therefore official notice has been taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate sub group definition information for defining as a sub group a set of a plurality of portion streams which are mutually changeable upon reproducing in the related group per official notice in claim 34 of copending Application No. 10/504,817 in order to efficiently perform the stream change, as the change of the sub group in the same related group.

10. **Claim 33** of this application is same as and encompasses claim of copending 7 Application No. 10/329,769 and, therefore, nonstatutory obviousness- type double patenting rejection is applied.

11. **Claims 27 – 31, 36 – 44, 46 and 47** of this application is same as and

encompasses respectively of copending claims 23 – 27, 30 – 38, 40 and 41

Application No. 10/504,817 and, therefore, nonstatutory obviousness- type double patenting rejection is applied.

This is a **provisional** obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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S.Y.H.
3/6/2008

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621